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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Dean R. Brown	Examiner: D. Fidei
Serial No. 10/090,885	Group Art Unit: 3728
Filed: March 4, 2002	
For: CONTAINER WHOSE SIDE WALL INCLUDES A SURFACE DISCONTINUITY TO HOLD SHRINKWRAP THERETO	Docket No. PWP0002/US/2

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REPLY BRIEF

Dear Sir or Madam:

This Reply Brief is being filed in response to the Examiner's Answer mailed on May 5, 2005, in connection with the above-identified patent application.

It is respectfully submitted that this Reply Brief is timely filed within two-months from the mailing date of the Examiner's Answer.

No fee(s) are believed to be due in filing this Reply Brief. However, if any fee(s) are required, please charge them to Deposit Account No. 50-1775 and notify us of the same.

Remarks

This Reply Brief responds to specific numbered paragraphs indicated in the Examiner's Answer as follows:

(5) Summary of Invention

The Examiner indicates that Applicant's discussion of how shrinkwrap can be replaced over a lid to help reseal a container according to the present invention is not germane to the claimed subject matter.¹

In response, Applicant points out that discussing this and other advantages of a container according to the present invention is very germane because it underscores the advance of Applicant's invention.

Applicant's claimed invention relates to containers having, *inter alia*, a side wall that tapers from top to bottom.² Such containers can be wrapped with shrinkwrap around the top and bottom of the container.³ However, a major pitfall of conventional containers that have a side wall that tapers from top to bottom is that if the shrinkwrap is subsequently torn to gain access to the container, the shrinkwrap tends to fall from the side of the container, thereby significantly diminishing the utility of the shrinkwrap.⁴ In addition, any labeling and/or designs attached to the shrinkwrap and/or positioned between the shrinkwrap and container sidewall without adhesive also fall from the side of the container and are typically lost or become discarded.⁵

Applicant's claimed invention overcomes this pitfall of conventional containers having a side wall that tapers from top to bottom by properly positioning a surface discontinuity according to the present invention on the side wall of the container. According to claim 1, a surface discontinuity according to the present invention is disposed on the tapered sidewall intermediate the rim and bottom of the container. The claimed surface discontinuity has a shape such that it can help hold shrinkwrap in

¹ See, Examiner's Answer at page 2.

² See, e.g., claim 1.

³ See, Applicant's specification at, e.g., page 6, lines 9-15.

⁴ See, *id.* at page 3, lines 25-27.

⁵ See, *id.* at page 3, line 22 to page 4, line 4, and page 8, line 23 to page 9, line 6.

position against the tapered sidewall.⁶ For example, see surface discontinuity 46 in FIGS. 1-4, which has a shape such that it can hold shrinkwrap layer 48 in position against the tapered side wall 34.

A container according to Applicant's claims is extremely unique because the surface discontinuity is between the rim and bottom of the container, yet the container is still able to nest with other containers. Being able to retain the shrinkwrap against the sidewall of such a container is highly desirable because, for example:

- any labeling and/or designs attached to the shrinkwrap and/or positioned between the shrinkwrap and container sidewall can likewise be retained against the sidewall; and
- if the shrinkwrap layer initially covers the entire lid after packaging, the excess or overhang portion of the shrinkwrap layer that has been removed to gain access to the container can be replaced over the lid to help reseal the container.⁷

As can be seen, Applicant's claimed invention is elegantly simple, yet highly effective. Simplicity should not be allowed to detract from the fact that Applicant's claimed invention is novel and nonobvious, and therefore patentable.

(6) Issues

The Examiner indicates that the rejections presented in the Non-Final Office Action mailed on October 10, 2003, are not at issue.

Applicant thanks the Examiner for clarifying the ambiguity in the Examiner's Office Actions concerning the standing rejections. Thus, Applicant notes that the rejections presented in the Final Office Action mailed May 11, 2004, are the only rejections at issue.

⁶ See, *id.* at page 2, line 27 to page 3, line 6.

⁷ See, *id.* at page 2, lines 25-28, page 5, lines 22 and 23, page 6, lines 3, 4, and 16-22, and page 9, lines 7-17.

(11) Response to Argument

Applicant responds to the numbered paragraphs, as indicated in the Examiner's "Response to Argument" section, as follows:

I. Rejection of claims 1, 2, 6, and 7 under 35 U.S.C. §102(b), as being anticipated by Ando (U.S. Patent No. 3,976,795).

Ando fails to teach a container having a surface discontinuity according to claim

1. Independent claim 1 recites a container including, *inter alia*:

- "a side wall ... tapering from top to bottom";
- "a surface discontinuity disposed on said side wall intermediate said rim and said container bottom"; and
- "a layer of shrinkwrap, wherein said layer of shrinkwrap is formed to and clings to at least a portion of said tapered side wall, wherein said layer of shrinkwrap is formed to and covers said surface discontinuity and conforms to the shape thereof." (Underling added for emphasis).

The Examiner improperly argues that Ando teaches a surface discontinuity according to claim 1. The Examiner improperly applies the Ando reference to claim 1 based on two faulty premises. First, the Examiner improperly argues that claim 1 does not recite enough structure to help hold the layer of shrinkwrap in position.⁸

To the contrary, claim 1 recites structure including a surface discontinuity positioned between the rim and bottom of the container as follows:

a surface discontinuity disposed on said side wall intermediate said rim and said container bottom (Underlining added).

And the specification makes it abundantly clear that a surface discontinuity of the present invention functions to help hold a layer of shrinkwrap in position against the tapered side wall of the container when the surface discontinuity is positioned between the rim and

⁸ See, Examiner's Answer at pages 4 and 5.

bottom of the container.⁹ For example, in connection with the embodiment illustrated in FIGS. 5-8, the specification clearly explains that:

As with the substantially square container 30 of Figs. 1-4, ridge 76 of container 60 helps hold shrinkwrap layer 78 in position against tapered side wall 64 even after shrinkwrap 78 is torn from the top of container 60.¹⁰

In short, the Examiner fails to see claim language that provides a surface discontinuity that helps hold a layer of shrinkwrap in position against the tapered side wall, but the recited term “surface discontinuity” provides that structure.

Second, the Examiner badly misconstrues the function and position of the “D” portion of the Ando container. The Examiner incorrectly posits that the “D” portion of the Ando container is a surface discontinuity as recited in claim 1.¹¹ However, the “D” portion of the Ando container is most certainly not a surface discontinuity according to Applicant’s claim 1 because portion “D” progressively narrows downward and does not function to hold the film against the container. If the film around the Ando container was removed from the around the top portion of the container, the film would fall from the side of the Ando container. The film on the Ando container is retained against the container because it completely encloses the container. Applicant notes that Ando does not specifically identify the “D” portion or even discuss it.

The Examiner also incorrectly posits that the “D” portion of the Ando container is positioned between the rim and bottom of the Ando container as is required with the surface discontinuity of claim 1.¹² To the contrary, viewing the entire container in Figure 1 of the Ando reference clearly shows that the “D” portion is part of the rim, which defines the opening of the container. The “D” portion is not a separate structure from the rim that is positioned between the rim and bottom of the container. Indeed, with respect to the Ando in view of Karevaara rejection below, the Examiner states that the sidewall of Ando is smooth,¹³ implying that the “D” portion must be part of the rim. Applicant

⁹ See, the specification at, e.g., page 2, lines 27 and 28, page 6, lines 16-22, and page 7, lines 10-12.

¹⁰ See, id. at page 7, lines 10-12.

¹¹ See, Examiner’s Answer at pages 4 and 5.

¹² See, id. at page 4.

¹³ See, id. at the bottom of page 5.

notes that the Ando reference does not define a rim and “D” portion of the Ando container as the Examiner posits.

In short, the shape and position of the “D” portion of the Ando container preclude it from being a surface discontinuity according to claim 1.

To sum up, the Examiner’s reliance on Ando to undermine the novelty of Applicant’s claims misconstrues claim 1 and the Ando reference. When claim 1 is properly construed and the Ando reference is properly understood, the difference between Applicant’s claims and the Ando reference is clear and patentably significant.

Accordingly, Applicant repeats the request that the rejection of claims 1, 2, 6, and 7 on appeal, under 35 U.S.C. 102(b) as being anticipated by Ando be withdrawn.

II. Rejection of claims 1, 2, and 6-10 under 35 U.S.C. §103(a) as being unpatentable over Ando in view of Karevaara (U.S. Patent No. 4,102,454).

Karevaara fails to cure the deficiencies of Ando discussed above because Karevaara fails to teach, motivate, or suggest modifying the Ando container by providing it with a surface discontinuity as required by claim 1.

Ando discloses a container for storing and preparing instant foodstuff, where the container and associated cover are completely enclosed with a heat contractible film in a substantially air-tight manner.¹⁴ As discussed above, Ando does not disclose a surface discontinuity disposed on a tapered side wall intermediate the rim and bottom of the container that helps hold shrinkwrap in position against a tapered sidewall. As acknowledged by the Examiner, Ando discloses a smooth sidewall.¹⁵ Moreover, Ando does not disclose a need or desire to retain the film against the container after opening the cover to prepare the food. Ando discloses using the film to improve storability until the food is prepared, at which time Ando explains that the film is merely “ripped open.”¹⁶ Ando does not disclose any other use for the film such as item identification or

¹⁴ See, Ando at col. 1, lines 11-14; col. 2, lines 1-5, 22-24, and 21-40; col. 3, lines 2-8; and Figure 1 (reference character 7).

¹⁵ See, Examiner’s Answer at the bottom of page 5.

¹⁶ See, Ando at col. 3, lines 9-14 and 19-29.

preparation instructions. Indeed, Ando explains that such things can be put on the cover of the container.¹⁷

Karevaara places projections on, in contrast, disposable drinking mugs having handles to prevent undesirable tilt and friction in a conventional stack of the drinking mugs caused by the handles on the mugs.¹⁸

The Examiner improperly argues that it would have been obvious to modify the Ando container to include the Karevaara projections based on two faulty lines of reasoning. First, the Examiner improperly posits modifying the Ando container to include the handle and, therefore the projections, disclosed on the Karevaara mug to help hold onto the Ando container when it includes hot contents.¹⁹

However, such reasoning is faulty because there would have been no motivation or suggestion to provide a handle on the Ando container because Ando explains the container is “heat-insulated and easy to handle by hand.”²⁰ Indeed, the Ando reference does not disclose a handle on its container or any need for a handle on its container, even when an Ando container may include contents that are hot because the container is heat-insulated and easy to handle by hand.

Second, the Examiner improperly posits modifying the Ando container to include the projections disclosed on the Karevaara mug to help separate a stack of Ando containers.²¹

However, such reasoning is improper because it is not based on the cited prior art references. The Ando reference does not disclose any challenges with separating a stack of its containers or even disclose that its containers are stacked. The Karevaara reference teaches the use of projections on its drinking mug to prevent undesirable tilt and friction in a conventional stack of disposable drinking mugs by creating a free space for the handle of the mug to reside in.²² The Karevaara reference does not disclose to generally incorporate its projections into any container to help facilitate separating stacked

¹⁷ See *id.* at col. 2, lines 17-22.

¹⁸ See, Karevaara at col. 1, lines 21-34.

¹⁹ See, Examiner’s Answer at page 6.

²⁰ See, Ando at the Abstract.

²¹ See, Examiner’s Answer at pages 5 and 6.

²² See, Karevaara at col. 1, lines 47-50 and 63-65 and col. 4, lines 3-6.

containers. Providing projections intended to alleviate a problem associated with handles does not provide any motivation or suggestion to use such projections in a container having no handles whatsoever. Neither Ando nor Karevaara would have suggested that the Ando container has tilt or friction problems associated with handles since the Ando container has no handles.

Clearly, the Examiner is picking and choosing certain aspects of the Karevaara reference and then stringing them together with certain aspects of the Ando reference to arrive at the subject matter of Applicant's claims using impermissible hindsight of Applicant's disclosure.

As a further deficiency, the Karevaara reference does not disclose that its containers are shrinkwrapped so the Karevaara reference does not even remotely suggest any synergy between a surface discontinuity, a tapered side wall, and a layer of shrinkwrap.

Accordingly, Applicant repeats the request that the rejection of claims 1, 2, and 6--10 under 35 U.S.C. 103(a) as being unpatentable over Ando in view of Karevaara be withdrawn.

III. Rejection of claim 3 under 35 U.S.C. §103(a) as being unpatentable over Ando in view of Marino, Jr. et al. (U.S. Patent No. 5,605,230) and over Ando in view of Karevaara, and further in view of Marino, Jr. et al.

Claim 3 depends from claim 1 and, therefore, includes all the features of claim 1. As discussed above, claim 1 is patentable over Ando and over Ando in view of Karevaara. The Examiner misunderstands Applicant's arguments with respect to claim 3 as follows:

With regard to claim 3 being unpatentable over under 35 U.S.C. 103, over Ando in view of Karevara and further in view of Marino, Jr. et al., appellant argues Marino, Jr. et al fails to cure the deficiencies of Ando and Karevara. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references....²³

²³ See, Examiner's Answer at page 6.

In other words, the Examiner misunderstands Applicant's arguments with respect to claim 3 because even if the shrinkwrap aspects of the Marino, Jr. et al. reference are combined with Ando or Ando in view of Karevaara, the Marino, Jr. et al. reference fails to cure the deficiencies of Ando and Ando in view of Karevaara with respect to claim 1. Specifically, the Marino, Jr. et al. reference does not teach, motivate, or suggest to modify the Ando container by including a surface discontinuity according to claim 1.

Accordingly, Applicant repeats the request that the rejection of claim 3 under 35 U.S.C. 103(a) as being unpatentable over Ando in view of Marino, Jr. et al. and over Ando in view of Karevaara, and further in view of Marino, Jr. et al. be withdrawn.

IV. Rejection of claim 4 under 35 U.S.C. §103(a) as being unpatentable over Ando in view of Gray, Jr. (U.S. Patent No. 5,489,126) and over Ando in view of Karevaara, and further in view of Gray, Jr.

Similar to the rejection of claim 3 above, the Examiner misunderstands Applicant's arguments with respect to dependent claim 4. That is, even if the adhesive-free label aspect of the Gray, Jr. reference is combined with Ando or Ando in view of Karevaara, the Gray, Jr. reference fails to cure the deficiencies of Ando and Ando in view of Karevaara with respect to claim 1 discussed above.

Accordingly, Applicant repeats the request that the rejection of claim 4 under 35 U.S.C. 103(a) as being unpatentable over Ando in view of Gray, Jr. and over Ando in view of Karevaara, and further in view of Gray, Jr. be withdrawn.

V. Rejection of claims 4 and 5 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ando in view of Kaufman (U.S. Patent No. 6,247,612) and over Ando in view of Karevaara, and further in view of Kaufman.

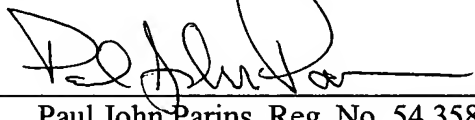
Similar to the rejection of claims 3 and 4 above, the Examiner misunderstands Applicant's arguments with respect this rejection of dependent claims 4 and 5. That is, even if the label aspects of the Kaufman reference are combined with Ando or Ando in view of Karevaara, the Kaufman reference fails to cure the deficiencies of Ando and Ando in view of Karevaara with respect to claim 1 discussed above.

Accordingly, Applicant repeats the request that the rejection of claims 4 and 5 under 35 U.S.C. 103(a) as being unpatentable over Ando in view of Kaufman and over Ando in view of Karevaara, and further in view of Kaufman be withdrawn.

In view of these remarks, it is respectfully submitted that pending claims 1-10 are in condition for allowance.

Dated: July 5, 2005

Respectfully Submitted,

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